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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,663	03/30/2000	Bjorn Markus Jakobsson	Jakobsson 22-2	8288
46304 7590 07/06/2007 RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			EXAMINER KARMIS, STEFANOS	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/538,663	Applicant(s) JAKOBSSON ET AL.	
	Examiner Stefano Karmis	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 18 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's appeal brief filed 29 September 2006.

Status of Claims

2. Claims 1-6, 8-13 and 15-20 are currently pending.

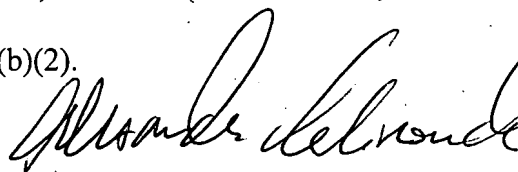
Response to Appeal

3. In view of the appeal brief filed on 29 September 2006, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER

Response to Arguments

4. Applicant's arguments with respect to the rejection of claims 1-6, 8-13 and 15-20 have been fully considered and are persuasive. However upon further examination a new grounds of rejection has been made as set forth below. Therefore, claims 1-6, 8-13 and 15-20 stand rejected.

Claim Objections

5. Claims 18 and 20 are objected to because of the following informalities: Regarding claim 18, line 2, the word "send" should be changed to "sender." Claim 20, line 2, the word "send" should be changed to "sender." Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 10 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenstein U.S. Patent 6,266,692.

Art Unit: 3691

Regarding claims 1 and 10, Greenstein discloses a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising:

determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 3, lines 38-51; Examiner notes that the passcode is analogous to a message authentication code; Figure 3);

filtering out at a gateway of the communication system email directed to the particular receiver that does not comprise valid MAC information (column 3, lines 53-67; Examiner notes that the message is routed to a holding tank when there is no passcode and emails not accepted are rejected and the unwanted email is purged); and

providing the particular receiver with email directed to the particular receiver that comprises valid MAC information (column 3, line 38-51; Examiner notes that the when the passcodes match, the user may then retrieve the email from the database via the email client).

Claims 17-20, further comprising determining if a particular sender is a registered sender of email to the particular receiver, wherein the particular sender becomes a registered sender by satisfying a requirement (column 2, lines 15-20; Examiner notes that all senders must be pre-approved and that individuals have unique passcodes; column 2, lines 59-64; Examiner notes that senders of the email who are not pre-approved can request approval).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein U.S. Patent 6,266,692 in view of Official Notice.

Claim 2, Greenstein teaches establishing an address related to an address associated with the particular receiver which will inform the particular sender that the particular receiver desires that the particular sender be able to send email to the particular receiver; and establishing by the particular receiver key which is forwarded to the particular sender by the particular receiver to inform the sender that the sender is authorized to send email the receiver and is now a registered sender and for use by the sender whenever the sender wishes to send email to the receiver (column 3, lines 38-67; Examiner notes that the passcode is part of the address for sending the email; Figure 3). Greenstein fails to teach establishing a cookie which indicates to the particular receiver whether the particular sender has satisfied the requirement to allow the particular sender to become a registered sender. Official Notice is taken that cookies are old and well known in the computer arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Greenstein to include cookies because it allows for faster authentication of emails when communicating between computers.

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Claims 3 and 11, Greenstein teaches generating a pseudorandom function with a keyed hash function using an input number comprising a unique serial number for use in generating an identifier for email between the sender and receiver (column 2, lines 25-42).

10. Claims 4-6, 8, 9, 12, 13, 15 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein U.S. Patent 6,266,692 in view of Official Notice in further view of Kirsch U.S. Patent 6,546,416.

Claims 4-6, 8, 9, 12, 13, 15 and 16, Greenstein teaches a method of preventing receipt by receivers of unwanted electronic mail messages sent by senders in a communication system, comprising: determining whether email to a particular receiver comprises valid message authentication code (MAC) information (column 3, lines 38-51; Examiner notes that the passcode is analogous to a message authentication code; Figure 3). Greenstein fails to teach establishing an address comprises sending email from the particular receiver to the particular sender using public key encryption and determining whether the message has valid MAC information. Kirsch teaches a method and system for selectively blocking delivery of bulk electronic mail utilizing public key encryption as well as other encoding and encrypting algorithms (column 6, lines 51 thru column 7, line 12). It would have been obvious to one of ordinary skill in the art to modify the teachings of Greenstein in view of Official Notice with the public key encryption teachings of Kirsch because it allows for authenticating emails effectively when filtering emails with the motivation of removing unwanted emails.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 7,188,358 Hisada et al. Email Access Control Scheme for Communication Network
Using Identification Concealment Mechanism.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
Stefano Karmis
25 June 2007

